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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/706,911	11/14/2003	Jack Robert Arron Clark	03.040.01	7656				
<div>7590 Zilka-Kotab, PC P.O. Box 721120 San Jose, CA 95172-1120</div>								
<div>EXAMINER MURDOUGH, JOSHUA A</div>								
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08/14/2008 PAPER								

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,911

Applicant(s)

CLARK, JACK ROBERT ARRON

Examiner

JOSHUA MURDOUGH

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14-22,24-32 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14-22,24-32 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. In response to Applicant's amendment, received on 28 April, new claims 43 and 44 have been added.
2. Claims 1, 2, 4-12, 14-22, 24-32, and 34-44 are currently pending and have been examined.

Claim Objections

3. Claims 1, 2, 4-12, 14-22, 24-30, 41, and 42 are objected to because of the following informalities: Claim 1, recites "A method distributing." It is recognized that it is actually the performance of the method that causes the results and not the method itself. Therefore, the Examiner believes it should read either, "A method for distributing" or "A method of distributing." Claims 11 and 21 have similar issues. Appropriate correction is required.
4. Claims 32 and 34-40 are objected to because of the following informalities: The claims recite, "A software supply controlling computer program as claimed" in claim 31 or one of its dependents. The scope of claim 31 includes the computer readable medium. Therefore, any claim depending from claim 31, either directly or indirectly, should reference the medium as well as the program. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4, 5, 8-12, 14, 15, 18-22, 24, 25, 28-32, 34, 35, and 38-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ishibashi (US 7,124,443).
7. As to claims 1, 11, 21, and 31, Ishibashi shows:
 - a. A method distributing a computer program product, said method comprising the steps of:
 - b. obtaining a licence ticket (Contents Use Right Discrimination Card, between 603 and 601, Figure 3) bearing a licence key (Discriminating Data, Figure 3);
 - c. inputting at a user computer **601** a download source computer address of a download source computer **603** of a supplier of said computer program (Column 8, line 45) product (The address has to be know to the user computer in order to have the download initiated, therefore, it had to be inputted);
 - d. establishing a computer network connection **607** between said user computer and said download source computer;
 - e. inputting said licence key at said user computer (Right arrow from Contents Use Right Discrimination Card to 601, Figure 3);
 - f. transmitting said licence key from said user computer via said computer network connection (Arrows from 601 to 605 to 607 to 603, Figure 3);
 - g. validating said licence key (Column 10, lines 4-13); and
 - h. if said licence key is valid, then:

(i) downloading said computer program product to said user computer (Column 9, lines 25-27); and

(ii) installing said computer program product to be resident upon said user computer (the decryption, as shown by Ishibashi, Columns 3-4, lines 62-10, is considered to place the program in position for use).

i. wherein when said licence ticket is purchased a seller of said licence ticket transmits data indicating sale of said licence ticket to said supplier of said computer program product (In order for the sale center **605** to know that the serial number has been distributed, it had to be reported by the seller, Column 10, lines 4-13).

7. Ishibashi shows the provider **603** and the management center **605** as separate servers.

8. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the teachings of Ishibashi to combine the two servers in order to make them integral (MPEP 2144.04), thus reducing the hardware and communications requirements.

9. As to claims 2, 12, 22, and 32, Ishibashi further shows:

said licence ticket is obtained via a purchase by a user (Column 9, lines 13-19).

10. As to claims 4, 14, 24, and 34, Ishibashi further shows:

receipt of said data indicating sale of said licence ticket validates said licence key associated with said licence ticket such upon subsequent receipt of said licence key at said download source computer said licence key will be treated as valid (if the serial number has been distributed, and the data from the user is proven authentic, Column 10, lines 4-13, it is treated as valid).

11. As to claims 5, 15, 25, and 35, Ishibashi further shows:

said data indicating sale of said licence ticket indicates one or more computer program products of which download and installation is to be allowed by said licence key of said licence ticket (Figure 4, the program/content ID corresponds to the key/serial number).

12. As to claims 8, 18, 28, and 38, Ishibashi further shows:

said licence key is hidden upon said licence ticket so as to be non-reversibly revealable by said user (Column 8, lines 65-67).

13. As to claims 9, 19, 29, and 39, Ishibashi further shows:

said licence key is hidden behind a scratch off covering upon said licence ticket (Column 8, lines 65-67).

14. As to claims 10, 20, 30, and 40, Ishibashi further shows:

said licence ticket bears a licence ticket identifier used to identify licence tickets released to be available to be obtained by a user (Column 8, lines 60-65).

15. As to claim 41, Ishibashi further shows:

said license ticket includes a front side and a back side (inherent for anything tangible, such as a card)

16. As to claim 43, Ishibashi further shows:

validating the licence key includes comparing the licence key with a list of valid licence keys (Figure 14).

17. As to claim 44, Ishibashi teaches a licence ticket. However, it does not expressly teach the download source computer address being printed on it. Nevertheless, the difference is only

found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* • 2106.

18. Claims 6, 16, 26, and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ishibashi as applied to claims 1, 11, 21, and 31 above, and further in view of Official Notice.

19. Ishibashi shows as is described in the rejection of claims 1, 11, 21, and 31 above, but does not show:

receipt of said data indicating sale of said licence ticket triggers said supplier of said computer program product to charge said seller for a licence to use said computer program product.

20. However, the Examiner believes this to merely be sale by consignment. The Examiner takes official notice that it is notoriously old and well known in the art to sell goods by consignment because it allows for someone more experienced in sales to actually sell the product and thus the owner of the product does not have to deal with the sale. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi to use consignment in order to reduce the risk on the part of the seller, which makes them more likely to carry the product.

21. Claims 7, 17, 27, and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ishibashi as applied to claims 1, 11, 21, and 31 above, and further in view of Powell (US 2001/0032189).

22. Ishibashi shows as is described in the rejection of claims 1, 11, 21, and 31 above, but does not show:

if said licence key is valid, then a user account is created associated with said licence key.

23. However, Powell shows the creation of a user account **268** upon verification of payment for a license (Paragraph 0167 & Title). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi with the user account of Powell, in order to save user preferences (Powell, paragraph 0167) and have better records and control of the transactions and content.

24. Claim 42 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ishibashi as applied to claim 1 above, and further in view of Berson (US 5,598,477).

25. Ishibashi shows as is described in the rejection of claim 1 above, but does not show:

said licence ticket includes a bar code identifying said license ticket.

26. However, Berson shows the use of a bar code **22BC** on a ticket, used to validate it (Column 3, lines 51-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ishibashi to include the barcode as described by Berson, in order to allow for the input to be scanned instead of manually input and to encrypt the data (Berson, Column 3, lines 55-56).

Response to Arguments

27. Applicant's arguments filed 28 April 2008 have been fully considered but they are not persuasive.

28. Applicants argue:

“Applicant...notes that a ‘software supply controlling computer program,’ as claimed by applicant in Claims 32 and 34-40, directly or indirectly refers to, and thereby references, a ‘software supply controlling computer program’ claimed by applicant in independent Claim 31, where the ‘software supply controlling computer program’ is ‘embodied on a tangible computer readable medium.’” (Remarks, page 10, paragraph 2)

29. Examiner's response:

The Examiner respectfully submits that the “tangible computer readable medium” in the above referenced claims is beyond the scope of a “software supply controlling computer program.” Therefore, if interpreted as suggested by Applicants, these claims would be subject to a rejection under 35 U.S.C 112 2nd Paragraph because one of ordinary skill in the art would not understand how the medium is part of the program. This may also result in a rejection under 35 U.S.C. 101 as software is non-statutory.

However, the scope of the medium clearly contains the software embedded within. It is readily known by one of ordinary skill in the art how to incorporate software onto a medium. Moreover, the medium is statutory subject matter as it is an article of manufacture. Therefore, Applicants are encouraged to reconsider their position.

30. Applicants argue:

"Further, the Examiner has "adopt[ed]... definitions-under the broadest reasonable interpretation standard-in all his claim interpretations" for the terms 'Install,' 'License/Licence,' and 'Ticket.' Applicant disagrees and asserts that all of applicant's claim language is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, and in further view of the definitions provided in the specification." (Remarks, Page 10, paragraph 3)

31. Examiner's response:

Applicant's desire for the terms of the claims to be given the plain and ordinary meaning has been noted. However, the Examiner maintains his position in accordance with MPEP 904.01 wherein it states, " During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification." The definitions provided are to show that the interpretations of the Examiner are within the scope the broadest reasonable interpretation.

32. Applicants argue:

"The Examiner has argued that 'applicant's use of optional language (e.g. 'if' in claim 1) allows for the 'if not' option to read on the claim' and has further argued that 'it is the Examiner's opinion that these limitations do not distinguish the claim from the prior art.' Applicant respectfully disagrees." (Remarks, page 10, paragraph 4)

33. Examiner's response:

As noted in paragraph 22 of the previous action, the Examiner's position is supported by MPEP 2106 II C (paragraph 4+), wherein it states, " Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

This is also supported by *Intel Corp. v. International Trade Commission*, 20 USPQ2d 1161 (Fed. Cir. 1991), wherein it was determined that, given two possibilities by the claim, an invention only needs to have one of them to infringe.

Clearly, by Applicants use of the word "if," they recognize that there are two possibilities: the condition can be satisfied or it can not be satisfied. Applicants provide steps that may be taken if it is satisfied. However, the Examiner maintains that the condition may not be satisfied as well. In which case, the steps would not be performed.

34. Applicants argue:

"Distributing the decoding key to a user after the user sends the content use rights discrimination card to a content use rights sale center for a content use rights issuance determination does not disclose "'a license ticket" that "bear[s] a licence key," as claimed." (Remarks, Page 11, paragraph 4+)

35. Examiner's response:

While not expressly referred to as a key, the discrimination data is used in the same manner as the key in the instant application. The label applied to a piece of data is

inconsequential to the function it performs and moreover, it is the function that is claimed not the label of the data.

36. Applicants argue:

“In addition, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. In view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)” (Remarks, Page 13, paragraph 1)

37. Examiner’s response:

The arguments Applicants make reference to the fact that the functionality is not expressly taught (e.g. “Nowhere in the above excerpt is a ‘download source computer address of a download source computer of a supplier of said computer program product’ taught that is ‘input[t] at a user computer’ (emphasis added), as specifically claimed.” (Remarks, Pages 12-13, paragraph spanning both pages)) However, as noted by Applicants, the functionality is inherent. Nowhere in the arguments did applicant rebut the fact that a computer has to know the address to communicate with another computer, or that in order to know the address it has to be input. None the less, the Examiner provides How the Internet Works by Preston Gralla as support for his inherency argument. Specifically, Chapters 4 and 5 teach about addresses and their critical role in a connection.

“To do just about anything on the Internet, and especially to send email, you need to understand Internet addresses. The Internet Protocol (IP) uses Internet address information to deliver mail and other data from computer to computer” (first paragraph of Chapter 4)

“After you’re connected to the Internet and you want to get to a Web site, you’ll need to know that Web site’s specific domain, such as zdnet.com. After you type in that domain, preceded by www., you’ll be sent to the site” (third paragraph of Chapter 5).

38. Applicants argue:

“With respect to Claims 1 and 11, the Examiner has relied on an ‘Arrow from 601 to 605’ in Figure 3 from the above reference to make a prior art showing of applicant's claimed ‘transmitting said licence key from said user computer to said download source computer via said computer network connection.’” (Remarks, Page 13, paragraph 2)

39. Examiner’s response:

The argument pertaining to the licence key has been addressed above. The argument in reference to the direction of the transmission of the key is not persuasive. Applicants are focusing on the labeling convention of the reference, and not using the citations used by the Examiner. The key referred to in the reference is *not* the same as what was cited as being the key in terms of the instant application.

40. Applicants argue:

“In addition, it appears that the Examiner has relied on an inherency argument regarding the above emphasized claim limitations. More specifically, the Examiner has argued that “[i]n order for the sale center 605 to know that the serial number has been distributed, it had to be reported by the seller.” Applicant respectfully disagrees and notes that, in view of the arguments made hereinabove, any such inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112).” (Remarks, Page 15, paragraph 2)

41. Examiner’s response:

Again, Applicants state that a discussion of what is expressly taught by the reference is a rebuttal of what is inherent. However, to properly rebut the inherency, the inherency itself has to be addressed. The Examiner maintains his position that “[i]n order for the sale center 605 to know that the serial number has been distributed, it had to be reported by the seller.”

42. Applicants argue:

“Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.” (Remarks, Page 16, paragraph 1)

43. Examiner’s response:

The Examiner has addressed each of Applicants arguments in regards to purported missing elements. The Examiner has shown in his arguments that each of the elements are, in fact, present, either expressly or inherently, and therefore, this argument is not persuasive.

44. Applicants argue:

“However, merely teaching that a content use rights discrimination card having an identifier that attests to the content use rights is sealed or designed as a scratch card, as in Ishibashi, fails to disclose a “licence key,” much less a technique “wherein said licence key is hidden upon said licence ticket so as to be non-reversibly revealable by said user” (emphasis added), in the context claimed by applicant.” (Remarks, Page 16, paragraph 4)

45. Examiner’s response:

Again, Applicant’s are focusing on the nomenclature of the reference. Just because the words “licence key” do not appear in the passage, does not mean that one is not present. The identifier attests to the content use rights, which is the same functionality given to the “licence key” in the instant application. The Examiner also maintains that a scratch off panel makes the identifier/key “non-reversibly revealable by said user.”

46. Applicants argue:

The Examiner’s taking of Official Notice (Remarks, Page 17, paragraphs 1-4)

47. Examiner’s response:

Applicants' attempt at traversing the Official Notice findings as stated in the previous Office Action (mailed 3/18/2008) is inadequate. Adequate traversal is a two step process. First Applicants must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires Applicants to specifically point out the supposed errors in the Office Action, Applicants must state *why* the Official Notice statement is not to be considered common knowledge or well known in the art.

In this application, while Applicants remarks have been taken to meet step (1), Applicants have failed step (2) since they have failed to argue *why* the Official Notice statement is not to be considered common knowledge or well known in the art. Because Applicants' traversal is inadequate, the Official Notice statement is taken to be admitted prior art. See MPEP 2144.03.

48. Applicants other arguments are in reference to the newly added claims. These claims have been addressed in the prior art section above.

Conclusion

49. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

50. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

52. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621